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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,853	11/30/2000	Masahiko Takeuchi	49657-871	8800
7590	12/19/2003			
McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096				EXAMINER ANDUJAR, LEONARDO
				ART UNIT 2826
				PAPER NUMBER DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/725,853	TAKEUCHI ET AL.
	Examiner Leonardo Andújar	Art Unit 2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 September 2003.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) 5-15 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-4 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11/30/00</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species I (claims 1-4) in a communication filed on 09/26/2003 is acknowledged.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102 and/or 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Initially, and with respect to claim 2 note that a "product by process" claim is directed to the product per se, no matter how actually made. See In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) and the related case law cited therein which makes it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or

obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. As stated in Thorpe, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); Buono v. Yankee Maid Dress Corp., 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir. 1935). **Note that Applicant has burden of proof in such cases** as the above case law makes clear.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Toshio (JP 63250148).

7. Regarding claim 1, Toshio (e.g. fig. 1) shows a semiconductor device comprising a device forming area formed on a semiconductor substrate and a dicing line area 8 arranged surrounding the device forming area, wherein the first and second registration marks 1 & 5 are formed in different shots area provided in the dicing line area, and the first and second registration marks include an auxiliary marks 6 (abstract).

8. Claims 2 and 3 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Toshio (JP 63250148).

9. Regarding claim 2, Toshio shows most aspects of the instant invention including a semiconductor device including a substrate divided into a plurality of areas defined by line 9 (see figure 2). This defined area includes the first registration mark 1 at an outermost peripheral portion, wherein one of the auxiliary marks 6 is located on an area position indication mark. As to the grounds of rejection under section 103(a), the

method for forming each area (e.g. photolithography), is an intermediate process step that does not affect the structure of the final device. See MPEP § 2113, which discusses the handling of "product by process" claims and recommends the alternative (§ 102 / § 103) grounds of rejection.

10. Regarding claim 3, the first registration mark 1 is formed in one of the four corners of the area defined by line 9. In this case, the area around the device forming area adjacent to the registration marks 1 & 3 is recognized as the first corner.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toshio (JP 63250148).

12. Regarding claim 4, Toshio shows most aspects to the instant invention including an auxiliary mark. Toshio does not disclose that the auxiliary mark can be made having an arrow like planar shape. However, this limitation, absent of any criticality, is only considered to be an obvious modification of the shape auxiliary mark disclosed by Prior Art as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. It would have been an obvious matter of design choice to make the auxiliary mark disclosed by Toshio having an arrow like planar shape since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

13. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kim (US 6,373,548)

14. Regarding claim 1, Kim (e.g. figs. 1 and 2) shows a semiconductor device comprising a device forming area 3 formed on a semiconductor substrate and a dicing line area 5 arranged surrounding the device forming area, wherein the first and second registration marks 7 are formed in different shots area provided in the dicing line area, and the first and second registration marks may include an auxiliary marks 12 (e.g. fig. 2c).

15. Claims 2-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Kim (US 6,373,548).

16. Regarding claim 2, Kim shows most aspects of the instant invention including a semiconductor device including a substrate divided into a plurality of areas 3. This defined area includes the first registration mark 7 at an outermost peripheral portion, wherein one of the auxiliary marks 12 is located on an area position indication mark. As to the grounds of rejection under section 103(a), the method for forming each area (e.g. photolithography), is an intermediate process step that does not affect the structure of the final device. See MPEP § 2113, which discusses the handling of "product by process" claims and recommends the alternative (§ 102 / § 103) grounds of rejection.

17. Regarding claim 3, the first registration mark 7 is formed in one of the four corners of the area.

18. Regarding claim 4, Kim shows that the auxiliary mark has an arrow like planar shape.

Conclusion

19. Papers related to this application may be submitted directly to Art Unit 2826 by facsimile transmission. Papers should be faxed to Art Unit 2826 via the Art Unit 2826 Fax Center located in Crystal Plaza 4, room 3C23. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2826 Fax Center number is **(703) 308-7722 or -7724**. The Art Unit 2826 Fax Center is to be used only for papers related to Art Unit 2826 applications.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leonardo Andújar** at **(703) 308-0080** and between the hours of 9:00 AM to 7:30 PM (Eastern Standard Time) Monday through Thursday or by e-mail via Leonardo.Andujar@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn, can be reached on (703) 308-6601.
21. Any inquiry of a general nature or relating to the status of this application should be directed to the **Group 2800 Receptionist** at **(703) 305-3900**.

Leonardo Andújar
Patent Examiner Art Unit 2826
LA
12/8/03

KENNETH J. REYNA
TELECOMMUNICATIONS EXAMINER
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